

Remarks

Claims 1-9, 11-22, and 24-34 remain pending. Claims 13-22, 24, and 26-34 have been withdrawn from consideration.

§ 112 Rejections

Claims 1-9, 11, 12, 14, and 25 stand rejected under 35 USC § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. In particular, the Examiner states that the expression "reduced adhesive properties appears vague, indefinite and confusing." Applicant disagrees for the reasons provided below.

Page 5, lines 12-15 of the specification provide as follows: "As used herein, reduced adhesive properties refers to a region with non-adhesive properties or adhesive properties less than the adhesive properties of the first adhesive region. As such, the concept of reduced adhesive properties is a comparison of the relative adhesive properties of the first and second adhesive regions." Thus, it is clear that in claim 1 the "reduced adhesive properties" of the second adhesive region are relative to the adhesive properties of the first adhesive region. Because this expression, when read in light of the specification, reasonably apprises those skilled in the art of the scope of the invention, the language is not vague or indefinite. Thus, Applicant submits that the expression "reduced adhesive properties" satisfies the requirements of the 35 USC §112, second paragraph. Reconsideration is requested.

In addition, the Examiner states that the phrases "top portion" and "bottom portion" in claim 1 are vague and indefinite. Applicant disagrees that the phrases "top portion" and "bottom portion" are vague or indefinite. At the outset, Applicant wishes to clarify that these phrases refer to top and bottom portion of the *structure*, not the adhesive tape. From certain statements made by the Examiner, it appears there may have been some confusion on this point. With this in mind, it is clear from the plain meaning of these phrases, and from the context in which these phrases appear in claim 1, that the top portion of the structure is just that, the top portion of the structure to which the first adhesive region of the adhesive tape is adhered. There is nothing vague or ambiguous about this. Similarly, the bottom portion is simply the bottom portion of the structure to which the second adhesive region of the adhesive tape is attached. Regarding the

Examiner's statement that it is not clear as to the size and shape of the portion, because the structure is intended to represent a wide variety of items that can be mounted with the adhesive tape (see e.g. page 3, lines 19-20 of the specification), and because the size and shape of the top and bottom portions have no bearing on the patentability of the present invention, Applicant submits that the size and shape of the top and bottom portions is irrelevant and that it is not necessary to identify the size and shape of these portions to satisfy the requirements of 35 USC §112, second paragraph.

Applicant further submits that because claim 1, including the phrases "top portion" and "bottom portion", when read in light of the specification (see e.g. page 5, lines 9-10 of the specification), reasonably apprises those skilled in the art of the scope of the invention, the language is not vague or indefinite. Reconsideration is therefore requested.

§ 103 Rejections

Claims 1-9, 11, 12, 14, and 25 stand rejected under 35 USC §103(a) as being unpatentable over Bries et al. (6,001,471) in view of Luhmann (5,626,931).

Independent claim 1 is directed to an adhesive article including a stretch releasing adhesive strip having a first adhesive region, a second adhesive region with reduced adhesive properties, and a pull tab adjacent the second adhesive region. Thus, in independent claim 1, the second adhesive region, which has reduced adhesive properties, is adjacent the pull tab. Neither Bries et al. or Luhmann, whether taken alone or in combination, disclose, teach or suggest such an adhesive article.

According to M.P.E.P. §706.02(j), a rejection under 35 U.S. C. §103 should set forth, among other things, the proposed modification of the applied references necessary to arrive at the claimed subject matter, and an explanation of why such proposed modification would have been obvious to one of ordinary skill in the art at the time the invention was made. In addition, this same section of the M.P.E.P. states that to establish a prima facie case of obviousness, three basic criteria must be met: (1) there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine the reference teachings; (2) there must be a reasonable expectation of success; and (3) the prior

art reference (or references when combined) must teach or suggest all the claim limitations. As discussed fully below, none of these requirements has been met.

To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references. In the subject application, this burden has not been met. The Examiner has not pointed to any teaching, express or implied, in the references that would suggest the claimed invention or any teaching in the prior art that suggests that the teachings could or should be combined. Nor has the Examiner presented a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references.

The Examiner asserts that "it would have been obvious to one skilled on the art to relocate the lower-adhesion portion to the opposite end of the adhesive article, motivated by the desire to be able to detach the adhesive article from the wall cleanly." This reasoning, however, is flawed because relocating the lower-adhesion portion to the opposite end of the adhesive article would have no effect on the adhesive article's ability to be cleanly removed from the wall. Consequently, a reasonable expectation of success is lacking. It is also noted that the Bries et al. adhesive tape is provided with an adhesive free zone to minimize the risk of snap back of the adhesive tape or catapulting of the object (see Bries et al. col. 2, lines 50-53), and that the present invention is provided with a second adhesive region with reduced adhesive properties to minimize damage to the substrate surface in failure mode (see present application page 2, line 22-23). Thus, the motivation offered by the Examiner to modify Bries et al., namely, to allow clean removal from the wall, differs from the actual motivation to provide an adhesive free zone in Bries et al. and the present invention. Because the lower-adhesion portion has no bearing on the tape's ability to be cleanly removed from a wall and because the suggested modification would destroy the essential feature of the Bries et al. adhesive tape, the Examiner has failed to identify or provide the requisite motivation to modify the Bries et al. reference to arrive at the present invention.

As noted in M.P.E.P. §2143, one of the requirements to show a prima facie case of obviousness is that the prior art references when combined must teach or suggest all the claim limitations. Because neither Bries et al. nor Luhmann teach an adhesive article having a second adhesive region with reduced adhesive properties adjacent a pull tab or an adhesive article having a second adhesive region with reduced adhesive properties adapted to attach a bottom portion of a structure to a substrate, even if there were the requisite motivation to combine the references, it is not seen how any of the claims can be considered obvious over this combination of references.

The Bries et al. patent U.S. patent No. 6,001,471 discloses a stretchable adhesive tape having a lower adhesion or non-adhesive portion on one adhesive surface so that a corresponding greater adhesion adhesive portion on the other side remains more aggressively adhered to a surface during stretch removal while the portion of the one adhesive surface is less aggressively adhered or completely released from its surface. The improvement of the Bries et al. tape lies in the ability to control the timing of the debonding of both surfaces so that one adhesive surface releases before the other. (Bries et al., col. 2, lines 41-44.) The improvement allows an object to be removed without risking substantial snap back of the adhesive tape or catapulting of the object. (Bries et al., col. 2, lines 50-53.)

To achieve this, however, the adhesive arrangement disclosed by Bries et al., is reversed from that of the present invention. That is, the lower adhesion or non-adhesive portion is provided adjacent the second end of the tape opposite the manually engageable pull tab. (See, e.g., Bries et al. col. 3, line 49; col. 4, lines 10, 26-27; col. 6, lines 10-16.) Thus, during removal, the lower adhesion or non-adhesive portion is the last portion of the adhesive tape to be removed from the associated object and/or surface. And when the adhesive tape is used to mount an object on a vertical wall surface, the lower adhesion or non-adhesive portion is adjacent the top of the mounted object.

The present invention, in contrast, provides a second adhesive region with reduced adhesive properties adjacent the pull tab. Accordingly, the second adhesive region is the first region to be removed during the removal process. And when the adhesive article of the present invention is used to attach an object to a surface, the second adhesive region is adjacent the lower end of the object.

The Luhmann reference does not cure the deficiency of the Bries et al. reference, and in fact suffers from the same deficiency as Bries et al. Luhmann has been cited for teaching adhesive strips with reducing adhesive properties toward the end of the strip. (See Luhmann claim 1 which provides in part: "the first strip end terminating in a pointed, serrated, convex curved or wavy shape and the first strip from said end extending to said second end which serves as a tab for pulling.") Accordingly, the teachings of this reference, whether taken alone or in combination with the teaching of Bries et al., in no way render the present invention unpatentable.

The Examiner has argued that it would have been obvious to one having ordinary skill in the art at the time the invention was made to rearrange the position of the first and second adhesion regions to still be able to facilitate a controlled sequential release of adhesive surfaces, and the tape can be removed without substantially damaging the surface, since it has been held that rearranging parts of an invention involves only routine skill in the art (citing *In re Japiske*). This is erroneous for the following reasons.

First, rearranging the position of the first and second adhesion regions would not allow for controlled sequential release of adhesive surfaces. Rather, it would prevent it. In order to achieve controlled sequential release, the adhesive surfaces at the end of adhesive strip during the removal process must be offset. By rearranging the position of the first and second adhesive regions as suggested by the Examiner, the offset would be eliminated and, consequently, controlled sequential release would be lost. Bries et al. explains that "with the use of [the Bries et al.] release strip, the one side completely debonds from its adhered surface prior to the complete debonding of the other side." (Bries et al., col. 3, lines 8-10. See also, Bries et al. col. 4, lines 47-52.) By rearranging the first and second adhesive regions, this characteristic feature of the Bries et al. tape would be destroyed.

Second, the Examiner's reliance on *In re Japiske* is misplaced because that case held that claims to a hydraulic power press which read on the prior art except with regard to the position of the starting switch were unpatentable because shifting the position of the starting switch would not have modified the operation of the device. Changing the position of the first and second adhesive regions of the Bries et al. adhesive tape as suggested by the Examiner, however, would completely alter the operation of the device because it would eliminate the controlled sequential release as demonstrated above. In addition, such a change would be in conflict with the teaching of the reference to provide a low or non-adhesive region at the end of the adhesive strip (i.e. at the end of the strip opposite the pull tab). Changing the position of the adhesive regions would therefore be contrary to the purpose of the Bries et al. invention and would alter the essential character of the adhesive tape. Accordingly, it would not have been obvious to one of ordinary skill to rearrange the position of the first and second adhesion regions as suggested by the Examiner.

In addition, the Bries et al. adhesive tape and the present invention are directed to solving different problems. Namely, Bries et al. is directed to allowing an object mounted with the adhesive tape to be removed without risking substantial snap back of the adhesive tape or catapulting of the object. This is achieved by providing a region having no adhesive properties or adhesive properties that are significantly reduced adjacent the second end of the tape. The present invention, in contrast, is directed to preventing damage to a wall surface during failure of the adhesive article. This is achieved by providing a low or non-adhesive region either at the bottom of the adhesive article or, in the case of a stretch releasing adhesive with a pull tab, adjacent to the pull tab.

Moreover, there is no suggestion or motivation, implied or express, to modify the Bries et al. or Luhmann references so that the non-adhesive or lower adhesive region is adjacent the pull tab. Rather, the adhesive tapes of these references are complete and functional in themselves, so there would be no reason to modify them in any manner.

In summary, the present invention as defined by independent claim 1 is patentable over the cited Bries et al. and Luhmann references because: (1) the references are structurally and functionally different than the present invention and address different problems; (2) there is no motivation to combine the references; (3) there is no motivation to modify the references in a

manner that would meet the claim; and (4) even if the references were combined, the references would still not meet the claims. Accordingly claim 1 is believed to be allowable over the cited references. Reconsideration is respectfully requested. The remaining dependent claims, as depending from allowable claims, are also deemed to be in condition for allowance.

Respectfully submitted,

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